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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/632,877

08/01/2003

Robert Joseph Panek JR.

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RATNERPRESTIA
P.O. BOX 980
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EXAMINER

KOEHLER, CHRISTOPHER M

ART UNIT

PAPER NUMBER

3726

MAIL DATE

DELIVERY MODE

11/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/632,877	Applicant(s) PANЕК ET AL.	
	Examiner Christopher M. Koehler	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-20 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/1/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 13-17 in the reply filed on 8/20/2008 is acknowledged.
2. The species restriction between claims 14-15 and claims 16-17 is hereby withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 13, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Sagstetter et al. (US Patent No. 5,092,462).

Claim 13:

Sagstetter teaches a method of unwinding a needle portion from a needle holder of a needle system having a second configuration (abstract) using a container system (figure 1) including a receptacle (10) and a lid (12, 250), the lid having an aperture (252, figure 13) configured to receive a needle system having a first configuration (a needle of a first configuration may be dropped through the aperture into the container and thus may be received by the aperture), said method comprising the steps of: (a) engaging an adapter (230) configured to receive the needle system having the second configuration in the lid aperture, thereby modifying the lid from being configured to receive the needle

Art Unit: 3726

system having the first configuration to being configured to receive the needle system having the second configuration (see figure 13); (b) inserting at least a portion of the needle system having the second configuration into the adapter aperture (figure 3), thereby engaging the needle portion to resist rotation of the needle portion with respect to the adapter; and (c) rotating the needle holder with respect to the adapter, thereby unwinding the needle portion from the needle system such that the needle portion can be released into the receptacle (abstract).

Claims 16 and 17:

Sagstetter teaches that the engaging step comprises engaging two or more flanges (232 on four sides) provided on the adapter with an edge of the lid (bordering the aperture).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sagstetter in view of Shaw (US Patent No. 6,474,472).

Claims 14 and 15:

Sagstetter teaches the structure of claim 13 above and additionally teaches a detent and depression formed on cooperating parts of the adapter but does not explicitly teach two or more detents formed on the adapter with depressions formed on the lid.

Art Unit: 3726

Shaw teaches a lid for needle disposal systems (102, figure 19) having an adapter (104) fitted therein and removably secured thereto by at least two detents (110) formed on the adapter and the lid.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided detents on the edges (232) of the adapter of Sagstetter and cooperating depressions on the inside edges of the aperture of Sagstetter in order to provide additional securement of the adapter to the aperture and assist in the alignment of the adapter to the lid.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Koehler whose telephone number is (571)272-3560. The examiner can normally be reached on Mon.-Fri. 7:30A-4:00P.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Application/Control Number: 10/632,877

Page 5

Art Unit: 3726

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jermie E Cozart/

Primary Examiner, Art Unit 3726

/C. M. K./

Examiner, Art Unit 3726

November 21, 2008